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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/807,442  | 03/24/2004  | Toshiaki Taguchi     | Q80676              | 4236             |
| 23373   | 7590        | 02/18/2005           | EXAMINER            |                  |
| SUGHRUE MION, PLLC<br>2100 PENNSYLVANIA AVENUE, N.W.<br>SUITE 800<br>WASHINGTON, DC 20037 |             |                      | KLEMANSKI, HELENE G |                  |
| ART UNIT  |             | PAPER NUMBER         |                     | 1755             |

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                  |                |
|------------------------------|------------------|----------------|
| <b>Office Action Summary</b> | Application No.  | Applicant(s)   |
|                              | 10/807,442       | TAGUCHI ET AL. |
|                              | Examiner         | Art Unit       |
|                              | Helene Klemanski | 1755           |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-16 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/22/04&8/19/04.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_.

## DETAILED ACTION

### ***Claim Objections***

1. Claims 14-16 are objected to because of the following informalities: in claim 14, line 2, the phrase "by using the inkjet ink according to claim 1" should be replaced with the phrase "comprising the inkjet ink set according to claim 1"; in claim 15, line 2, the phrase "by using the inkjet ink according to claim 2" should be replaced with the phrase "comprising the inkjet ink set according to claim 2" and in claim 16, line 2, the phrase "by using the inkjet ink according to claim 3" should be replaced with the phrase "comprising the inkjet ink set according to claim 3". Appropriate correction is required.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-12 and 14-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 and 9-13 of copending Application No. 10/611,990 (US 2004/0055508). Although the

conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are generic to said patent claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-12 and 14-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2 and 5-11 of copending Application No. 10/805,251 (US 2005/0001890). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are generic to said patent claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-12 and 14-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 6 and 8-10 of copending Application No. 10/600,831 (US 2004/0011248). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said patent claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 10/806,452 (US 2004/0189765). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said patent claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-23 of copending Application No. 10/660,653 (US 2004/0080595). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are generic to said patent claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 8-16 of copending Application No. 10/806,424 (US 2004/0194660). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said patent claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

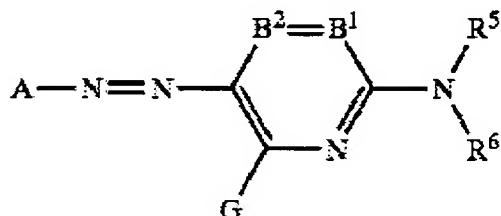
9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-12 and 14-16 are rejected under 35 U.S.C. 102(a) as being anticipated by EP 1378550.

EP 1378550 teach an ink for ink jet recording comprising water, a water-soluble organic solvent, a dye of the formula



wherein A represents a five-membered heterocyclic ring; B<sup>1</sup> and B<sup>2</sup> each represents

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=N-, =CR<sup>1</sup>- or =CR<sup>2</sup>- and when one of B<sup>1</sup> and B<sup>2</sup> represents =N-, the other represents =CR<sup>1</sup>- or =CR<sup>2</sup>-; R<sup>5</sup> and R<sup>6</sup> each independently represents H or a substituent and G, R<sup>1</sup> and R<sup>2</sup> each independently represents H or a substituent and 0.001-50 wt% of a betaine surfactant having both a cationic site such as a nitrogen atom of an amine and an anionic site. The ink may further contain 0.001-5 wt% of a nonionic surfactant (i.e. antifoaming agent for preventing bubbles) such as an alkyl allyl ether ethylene oxide addition product, a polyoxyalkylene of the formula

$\text{HO}-(\text{C}_2\text{H}_4\text{O})_n-(\text{C}_3\text{H}_6\text{O})_m-(\text{C}_2\text{H}_4\text{O})_n-\text{OH}$ , alkyl ester type of the formula  $\text{R}_1(\text{R}_2)\text{CHCOO}(\text{C}_2\text{H}_4\text{O})_n$  wherein R<sub>1</sub> and R<sub>2</sub> each represents an alkyl group having 1-10 carbon atoms and n=1-8 and acetylenediol and its addition product with 0-8 moles of ethylene oxide. The inks may further be filtered to remove impurities. The filter preferably has an effective diameter of 1  $\mu\text{m}$  or less. The inks are printed onto a substrate such as a recording paper by ink jet printing process. The recording paper can comprise chemical pulp, mechanical pulp or waste paper pulp. The substrate can comprise an image receiving layer and a back coat layer. The image receiving layer contains a porous material, an aqueous binder and a white pigment such as calcium carbonate, kaolin, talc, clay, diatomaceous earth, synthetic amorphous silica, aluminum silicate, magnesium silicate, calcium silicate, aluminum hydroxide, alumina, lithopone, zeolite, barium sulfate, calcium sulfate, titanium dioxide, zinc sulfide and zinc carbonate. The back coat layer contains an aqueous binder and a white pigment. See pages 2-5, azo dye compounds on pages 12-24, pages 27-30, page 31, lines 8-22, page 32, lines 18-26, page 33, lines 47-50, page 34, lines 6-21, pages 37-38, page 40, lines 4-10,

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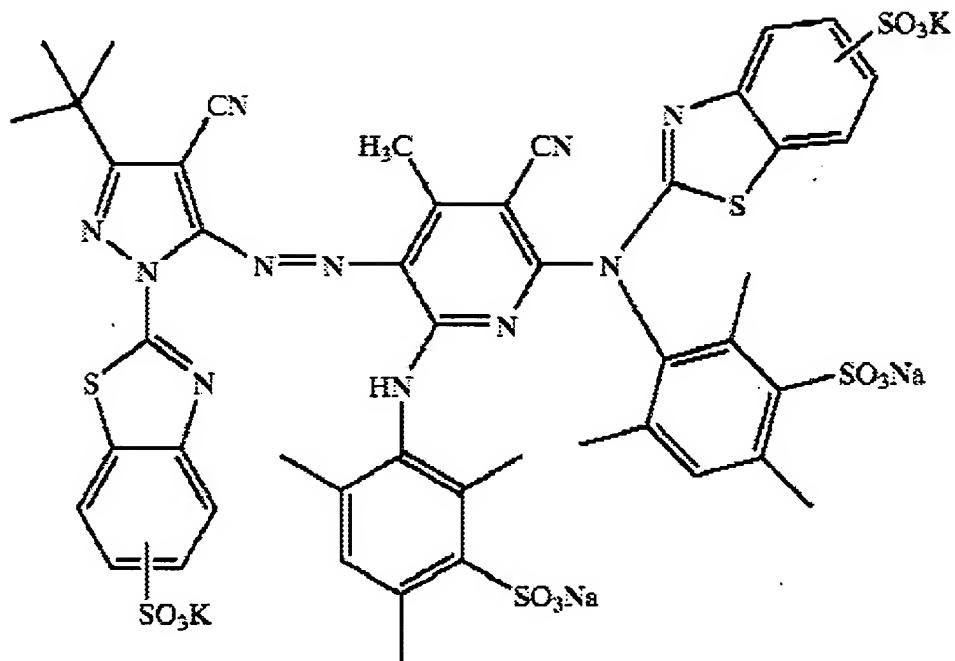
example 1, Table 14 and claims 1-7 and 9, 10, 12 and 13. The ink for ink jet recording as taught by EP 1378550 appears to anticipate the present claims.

The only limitation in the claim 9 not found by the examiner is the oxidation potential of the dye. However, this limitation is considered inherent because there does not appear to be any reason why the cited reference would not contain a dye with applicants claimed oxidation potential since the azo dye of EP 1378550 is the same structural formula as claimed by applicants.

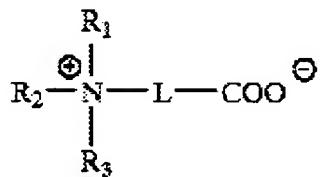
Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

11. Claims 1-12 and 14-16 are rejected under 35 U.S.C. 102(a) as being anticipated by EP 1375608.

EP 1375608 teach an ink set comprising at least four ink jet ink compositions wherein each ink comprises an aqueous medium, a dye of the formula



and 0.01-20 wt% of a betaine surfactant of the formula



wherein  $\text{R}_1$ ,  $\text{R}_2$  and  $\text{R}_3$  each represents an alkyl group, an aryl group or a heterocyclic group wherein at least two of  $\text{R}_1$ ,  $\text{R}_2$  and  $\text{R}_3$  may be linked with each other to form a ring;  $\text{L}$  represents a divalent linking group and at least one of  $\text{R}_1$ ,  $\text{R}_2$ ,  $\text{R}_3$  and  $\text{L}$  is a group having from 8 to 40 carbon atoms. Each ink jet ink compositions may further contain 0.001-15 wt% of a nonionic surfactant (i.e. defoaming agent) such as polyoxyethylene nonylphenyl ether, polyoxyethylene naphthyl ether, polyoxyethylene octylphenyl ether and SURFYNOLS (i.e. acetylene-based polyoxyethylene oxide surfactant). The inks are printed onto a substrate such as a recording paper by ink jet printing process. The recording paper can comprise chemical pulp, mechanical pulp or waste paper pulp.

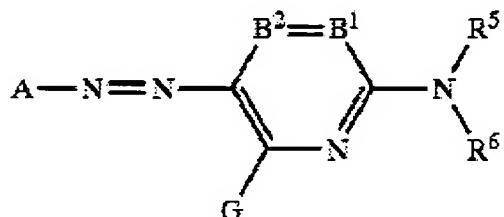
The substrate can comprise an image receiving layer and a back coat layer. The image receiving layer contains a porous material, an aqueous binder and a white pigment such as calcium carbonate, kaolin, talc, clay, diatomaceous earth, synthetic amorphous silica, aluminum silicate, magnesium silicate, calcium silicate, aluminum hydroxide, alumina, lithopone, zeolite, barium sulfate, calcium sulfate, titanium dioxide, zinc sulfide and zinc carbonate. The back coat layer contains an aqueous binder and a white pigment. Sound wave oscillation may also be performed on the inks for preventing the inks from generating bubbles by the pressure applied to a recording head. The sound wave is performed by applying sound wave energy which is the same with or higher than the energy applied at a recording head during the manufacture of the inks. The inks may further be filtered to remove impurities. The filter preferably has an effective diameter of 1  $\mu$ m or less. EP 1375608 further teaches an ink jet recording method using the above ink set comprising the above inks. See pages 2-4, compounds X-1 to X-18, page 9, lines 31-55, page 15, lines 10-34, page 16, lines 25-35, page 17, lines 22-50, examples 1 and 2, Tables 1 and 3 and claims 1, 2, 6 and 8-10. The ink set comprising at least four ink jet ink compositions as taught by EP 1375608 appears to anticipate the present claims.

The only limitation in the claim 9 not found by the examiner is the oxidation potential of the dye. However, this limitation is considered inherent because there does not appear to be any reason why the cited reference would not contain a dye with applicants claimed oxidation potential since the azo dye of EP 1375608 is the same structural formula as claimed by applicants.

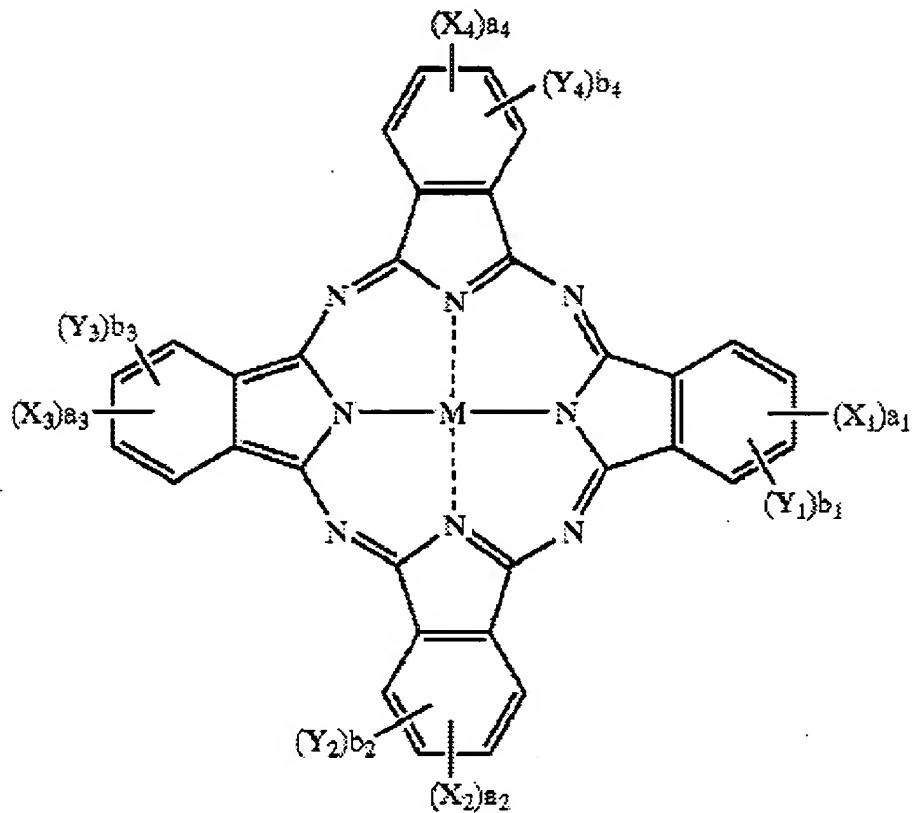
Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

12. Claims 1-16 are rejected under 35 U.S.C. 102(a) as being anticipated by EP 1473336.

EP 1473336 teach an ink for ink jet recording comprising water, a water-soluble organic solvent, a dye of the formula



wherein A represents a five-membered heterocyclic ring; B<sup>1</sup> and B<sup>2</sup> each represents =N-, =CR<sup>1</sup>- or =CR<sup>2</sup>- and when one of B<sup>1</sup> and B<sup>2</sup> represents =N-, the other represents =CR<sup>1</sup>- or =CR<sup>2</sup>-; R<sup>5</sup> and R<sup>6</sup> each independently represents H or a substituent and G, R<sup>1</sup> and R<sup>2</sup> each independently represents H or a substituent or the formula



wherein  $X_1$ ,  $X_2$ ,  $X_3$  and  $X_4$  each represents  $-\text{SO}-\text{Z}$ ,  $-\text{SO}_2\text{Z}$ ,  $-\text{SO}_2\text{NR}_1\text{R}_2$ , a sulfo group,  $-\text{CON R}_1\text{R}_2$  or  $-\text{CO}_2\text{R}_1$ ;  $Z$  represents an alkyl, a cycloalkyl, an alkenyl, an aralkyl, an aryl or a heterocyclic group;  $R_1$  and  $R_2$  each represents H, an alkyl, a cycloalkyl, an alkenyl, an aralkyl, an aryl or a heterocyclic group;  $Y_1$ ,  $Y_2$ ,  $Y_3$  and  $Y_4$  each represents a monovalent substituent;  $a_1$ -  $a_4$  each represents an integer of 0-4 wherein  $a_1$ -  $a_4$  are not all zero at the same time and  $b_1$ -  $b_4$  each represents an integer of 0-4 and 0.001-50 wt% of a betaine compound of the formula



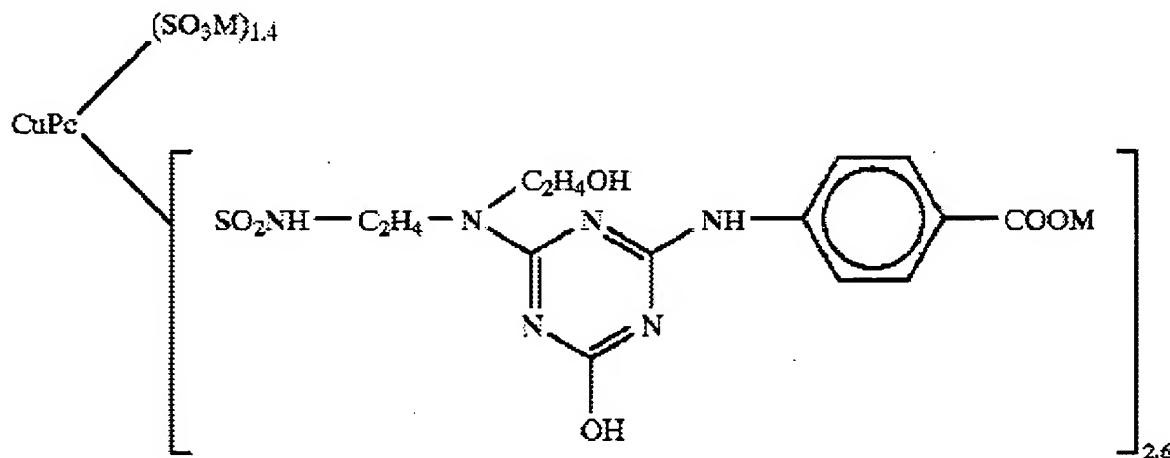
wherein  $R$  represents an alkyl, an aryl or a heterocyclic group;  $L$  is a divalent linking group;  $M$  is H, an alkali metal cation, ammonium ion or an organic amine cation;  $q$  and  $r$

each represents an integer of 1 or more; k and m each represents 0 or an integer of 1 or more; n represents an integer of 1 or more and p represents 0 or an integer of 1 or more. EP 1473336 further teaches an ink set for ink jet recording comprising the above ink composition and optionally the dye density in each ink is different to form a dark ink and a light ink. Each ink jet ink compositions may further contain 0.001-15 mass% of a nonionic surfactant (i.e. defoaming agent) such as polyoxyethylene nonylphenyl ether, polyoxyethylene naphthyl ether, polyoxyethylene octylphenyl ether and SURFYNOLS (i.e. acetylene-based polyoxyethylene oxide surfactant). The inks are printed onto a substrate such as a recording paper by ink jet printing process. The recording paper can comprise chemical pulp, mechanical pulp or waste paper pulp. The substrate can comprise an image receiving layer and a back coat layer. The image receiving layer contains a porous material, an aqueous binder and a white pigment such as calcium carbonate, kaolin, talc, clay, diatomaceous earth, synthetic amorphous silica, aluminum silicate, magnesium silicate, calcium silicate, aluminum hydroxide, alumina, lithopone, zeolite, barium sulfate, calcium sulfate, titanium dioxide, zinc sulfide and zinc carbonate. The back coat layer contains an aqueous binder and a white pigment. The inks may further be filtered to remove impurities. See pages 2-7, azo dye compounds on pages 13-25, page 28, lines 25-30, phthalocyanine dye compounds on pages 38-50, page 58, line 57 – page 59, line 3, compounds W-1 to W18 and X-1 to X-16, page 66, lines 32-37, page 70, lines 27-35, examples 1-4 and claims 1, 2, 8, 9, 13, 15, 20, 22, 24 and 25. The ink for ink jet recording as taught by EP 1473336 appears to anticipate the present claims.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

13. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Hiraoka et al.

Hiraoka et al. teach an ink for ink jet recording comprising water, a water-soluble organic solvent, a dye of the formula



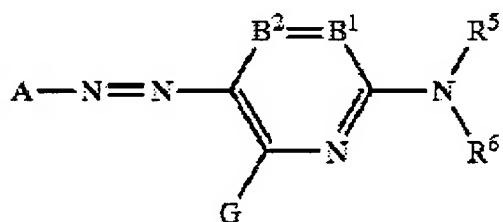
betaine and a nonionic surfactant. The ink may further be filtered to remove impurities. See examples 15, 17, 24, 26, 30, 37, 42, 46, 49, 54 and claims 1 and 21-24. The ink for ink jet recording as taught by Hiraoka et al. appears to anticipate the present claims.

The only limitation in the claim 9 not found by the examiner is the oxidation potential of the dye. However, this limitation is considered inherent because there does not appear to be any reason why the cited reference would not contain a dye with applicants claimed oxidation potential since the phthalocyanine dye of Hiraoka et al. is the same structural formula as claimed by applicants.

14. Claims 1-12, and 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Miyamoto et al (US 2004/0055508).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Miyamoto et al (US 2004/0055508) teach an ink for ink jet recording comprising water, a water-soluble organic solvent, a dye of the formula



wherein A represents a five-membered heterocyclic ring; B<sup>1</sup> and B<sup>2</sup> each represents =N-, =CR<sup>1</sup>- or =CR<sup>2</sup>- and when one of B<sup>1</sup> and B<sup>2</sup> represents =N-, the other represents =CR<sup>1</sup>- or =CR<sup>2</sup>-; R<sup>5</sup> and R<sup>6</sup> each independently represents H or a substituent and G, R<sup>1</sup> and R<sup>2</sup> each independently represents H or a substituent and 0.001-50 wt% of a betaine surfactant having both a cationic site such as a nitrogen atom of an amine and an anionic site. The ink may further contain 0.001-5 wt% of a nonionic surfactant (i.e. antifoaming agent for preventing bubbles) such as an alkyl allyl ether ethylene oxide addition product, a polyoxyalkylene of the formula

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$\text{HO}-(\text{C}_2\text{H}_4\text{O})_n-(\text{C}_3\text{H}_6\text{O})_m-(\text{C}_2\text{H}_4\text{O})_n-\text{OH}$ , alkyl ester type of the formula  $\text{R}_1(\text{R}_2)\text{CHCOO}(\text{C}_2\text{H}_4\text{O})_n$  wherein  $\text{R}_1$  and  $\text{R}_2$  each represents an alkyl group having 1-10 carbon atoms and  $n=1-8$  and acetylenediol and its addition product with 0-8 moles of ethylene oxide. The inks may further be filtered to remove impurities. The filter preferably has an effective diameter of 1  $\mu\text{m}$  or less. The inks are printed onto a substrate such as a recording paper by ink jet printing process. The recording paper can comprise chemical pulp, mechanical pulp or waste paper pulp. The substrate can comprise an image receiving layer and a back coat layer. The image receiving layer contains a porous material, an aqueous binder and a white pigment such as calcium carbonate, kaolin, talc, clay, diatomaceous earth, synthetic amorphous silica, aluminum silicate, magnesium silicate, calcium silicate, aluminum hydroxide, alumina, lithopone, zeolite, barium sulfate, calcium sulfate, titanium dioxide, zinc sulfide and zinc carbonate. The back coat layer contains an aqueous binder and a white pigment. See paras. 0009-0013, para. 0019, paras. 0023-0029, paras. 0041-0046, para. 0048, azo dye compounds on pages 9-27, para. 0116, paras. 0140-0149, para. 0163, para. 0172, paras. 0183-0184, paras. 0190-0197, paras. 0232-0237, paras. 0250-0252, example 1, Table 14 and claims 1-7 and 9, 10, 12 and 13. The ink for ink jet recording as taught by Miyamoto et al (US 2004/0055508) appears to anticipate the present claims.

The only limitation in the claim 9 not found by the examiner is the oxidation potential of the dye. However, this limitation is considered inherent because there does not appear to be any reason why the cited reference would not contain a dye with

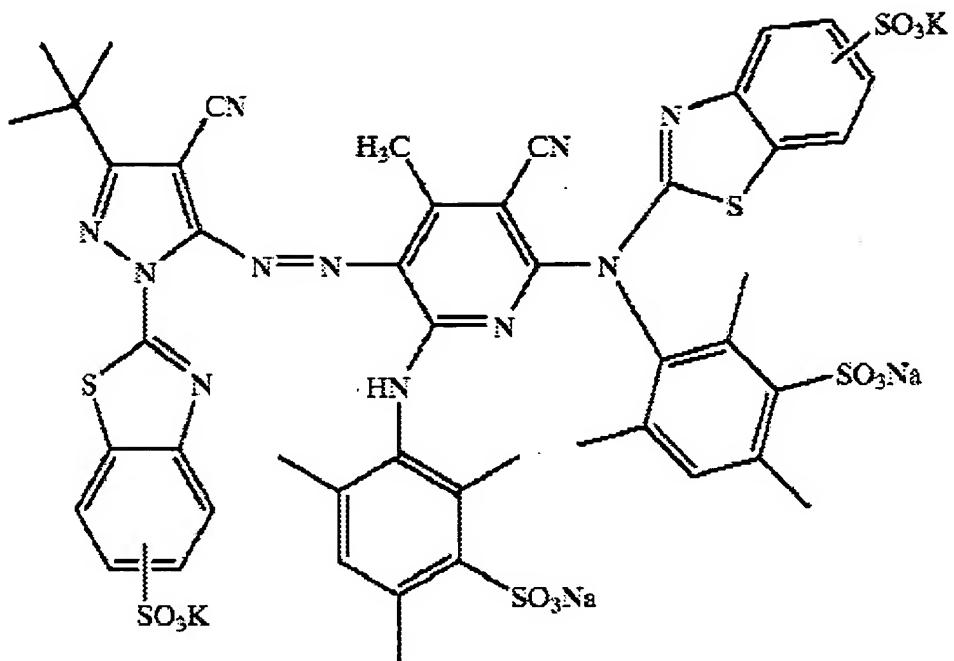
applicants claimed oxidation potential since the azo dye of Miyamoto et al. (US 2004/0055508) is the same structural formula as claimed by applicants.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

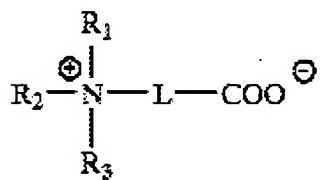
15. Claims 1-12 and 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Taguchi et al (US 2004/0011248).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Taguchi et al (US 2004/0011248) teach an ink set comprising at least four ink jet ink compositions wherein each ink comprises an aqueous medium, a dye of the formula



and 0.01-20 wt% of a betaine surfactant of the formula



wherein  $\text{R}_1$ ,  $\text{R}_2$  and  $\text{R}_3$  each represents an alkyl group, an aryl group or a heterocyclic group wherein at least two of  $\text{R}_1$ ,  $\text{R}_2$  and  $\text{R}_3$  may be linked with each other to form a ring;  $\text{L}$  represents a divalent linking group and at least one of  $\text{R}_1$ ,  $\text{R}_2$ ,  $\text{R}_3$  and  $\text{L}$  is a group having from 8 to 40 carbon atoms. Each ink jet ink compositions may further contain 0.001-15 wt% of a nonionic surfactant (i.e. defoaming agent) such as polyoxyethylene nonylphenyl ether, polyoxyethylene naphthyl ether, polyoxyethylene octylphenyl ether and SURFYNOLS (i.e. acetylene-based polyoxyethylene oxide surfactant). The inks are printed onto a substrate such as a recording paper by ink jet printing process. The recording paper can comprise chemical pulp, mechanical pulp or waste paper pulp.

The substrate can comprise an image receiving layer and a back coat layer. The image receiving layer contains a porous material, an aqueous binder and a white pigment such as calcium carbonate, kaolin, talc, clay, diatomaceous earth, synthetic amorphous silica, aluminum silicate, magnesium silicate, calcium silicate, aluminum hydroxide, alumina, lithopone, zeolite, barium sulfate, calcium sulfate, titanium dioxide, zinc sulfide and zinc carbonate. The back coat layer contains an aqueous binder and a white pigment. Sound wave oscillation may also be performed on the inks for preventing the inks from generating bubbles by the pressure applied to a recording head. The sound wave is performed by applying sound wave energy which is the same with or higher than the energy applied at a recording head during the manufacture of the inks. The inks may further be filtered to remove impurities. The filter preferably has an effective diameter of 1  $\mu$ m or less. Taguchi et al. (US 2004/0011248) further teach an ink jet recording method using the above ink set comprising the above inks. See paras. 0007-0019, compounds X-1 to X-18, paras. 0031-0032, paras. 0072, paras. 0075-0078, para. 0088, paras. 0136-0142, paras. 0153-0155, paras. 0165-0167, para. 0173, para. 0178, examples 1 and 2, Tables 1 and 3 and claims 1, 2, 6 and 8-10. The ink set comprising at least four ink jet ink compositions as taught by Taguchi et al (US 2004/0011248) appears to anticipate the present claims.

The only limitation in the claim 9 not found by the examiner is the oxidation potential of the dye. However, this limitation is considered inherent because there does not appear to be any reason why the cited reference would not contain a dye with

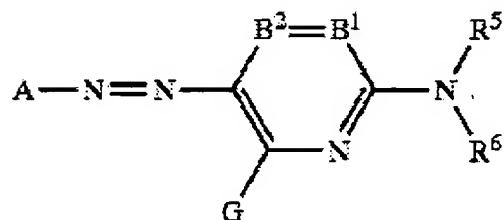
applicants claimed oxidation potential since the azo dye of Taguchi et al. (US 2004/0011248) is the same structural formula as claimed by applicants.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

16. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Taguchi et al. (US 2004/0080595).

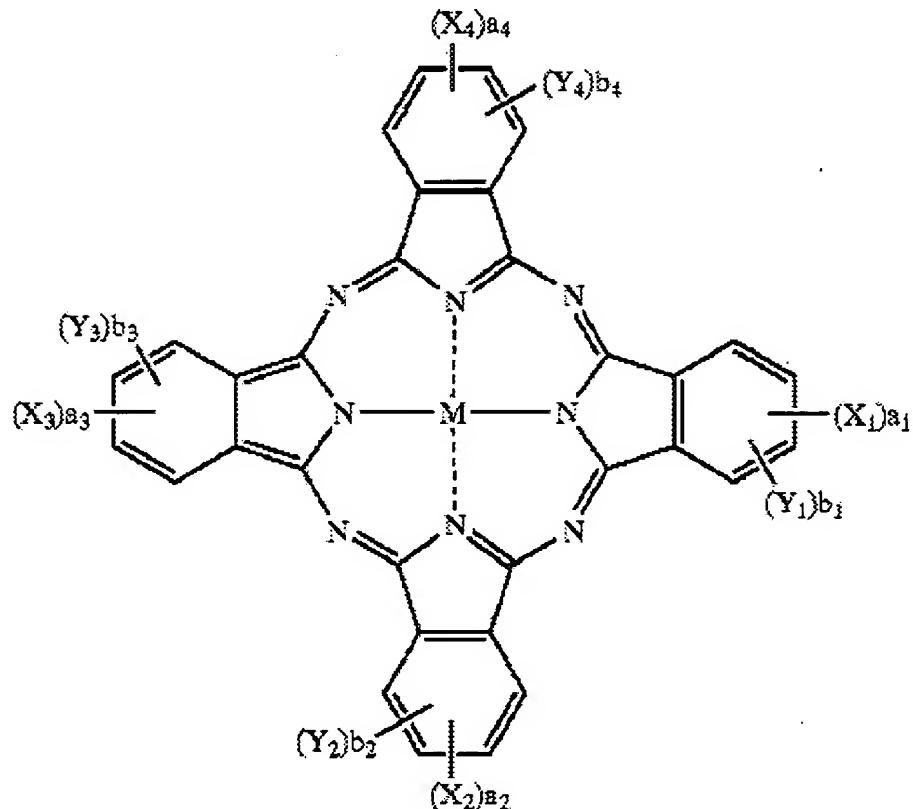
The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Taguchi et al. (US 2004/0080595) teach an ink for ink jet recording comprising water, a water-soluble organic solvent, a dye of the formula

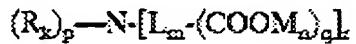


wherein A represents a five-membered heterocyclic ring; B<sup>1</sup> and B<sup>2</sup> each represents

=N-, =CR<sup>1</sup>- or =CR<sup>2</sup>- and when one of B<sup>1</sup> and B<sup>2</sup> represents =N-, the other represents =CR<sup>1</sup>- or =CR<sup>2</sup>-; R<sup>5</sup> and R<sup>6</sup> each independently represents H or a substituent and G, R<sup>1</sup> and R<sup>2</sup> each independently represents H or a substituent or the formula



wherein X<sub>1</sub>, X<sub>2</sub>, X<sub>3</sub> and X<sub>4</sub> each represents -SO-Z, -SO<sub>2</sub>Z, -SO<sub>2</sub>NR<sub>1</sub>R<sub>2</sub>, a sulfo group, -CON R<sub>1</sub>R<sub>2</sub> or -CO<sub>2</sub>R<sub>1</sub>; Z represents an alkyl, a cycloalkyl, an alkenyl, an aralkyl, an aryl or a heterocyclic group; R<sub>1</sub> and R<sub>2</sub> each represents H, an alkyl, a cycloalkyl, an alkenyl, an aralkyl, an aryl or a heterocyclic group; Y<sub>1</sub>, Y<sub>2</sub>, Y<sub>3</sub> and Y<sub>4</sub> each represents a monovalent substituent; a<sub>1</sub>- a<sub>4</sub> each represents an integer of 0-4 wherein a<sub>1</sub>- a<sub>4</sub> are not all zero at the same time and b<sub>1</sub>- b<sub>4</sub> each represents an integer of 0-4 and 0.001-50 wt% of a betaine compound of the formula



wherein R represents an alkyl, an aryl or a heterocyclic group; L is a divalent linking group; M is H, an alkali metal cation, ammonium ion or an organic amine cation; q and r each represents an integer of 1 or more; k and m each represents 0 or an integer of 1 or more; n represents an integer of 1 or more and p represents 0 or an integer of 1 or more. Taguchi et al. (US 2004/0080595) further teach an ink set for ink jet recording comprising the above ink composition and optionally the dye density in each ink is different to form a dark ink and a light ink. Each ink jet ink compositions may further contain 0.001-15 wt% of a nonionic surfactant (i.e. defoaming agent) such as polyoxyethylene nonylphenyl ether, polyoxyethylene naphthyl ether, polyoxyethylene octylphenyl ether and SURFYNOLS (i.e. acetylene-based polyoxyethylene oxide surfactant). The inks are printed onto a substrate such as a recording paper by ink jet printing process. The recording paper can comprise chemical pulp, mechanical pulp or waste paper pulp. The substrate can comprise an image receiving layer and a back coat layer. The image receiving layer contains a porous material, an aqueous binder and a white pigment such as calcium carbonate, kaolin, talc, clay, diatomaceous earth, synthetic amorphous silica, aluminum silicate, magnesium silicate, calcium silicate, aluminum hydroxide, alumina, lithopone, zeolite, barium sulfate, calcium sulfate, titanium dioxide, zinc sulfide and zinc carbonate. The back coat layer contains an aqueous binder and a white pigment. The inks may further be filtered to remove impurities. See para. 0016, paras. 0032-0034, paras. 0042-0052, compounds X-1 to X-20, paras. 0222-0227, paras. 0271-0277, Tables 1-4, paras. 0355-0357, paras. 0383-

0393, compounds (I-1) to (I-12), Tables 14-20, paras. 0431-0438, para. 0471, paras. 0475-0479, paras. 0489-0491, examples 3 and 4. Tables 27 and 29 and claims 1, 5, 6 and 11-23. The ink for ink jet recording as taught by Taguchi et al (US 2004/0080595) appears to anticipate the present claims.

The only limitation in the claim 9 not found by the examiner is the oxidation potential of the dye. However, this limitation is considered inherent because there does not appear to be any reason why the cited reference would not contain a dye with applicants claimed oxidation potential since the azo dye of Taguchi et al (US 2004/0080595) is the same structural formula as claimed by applicants.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

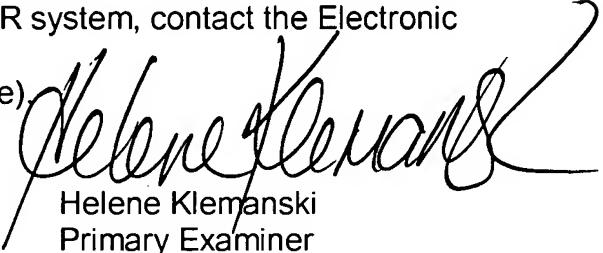
### ***Conclusion***

The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is (571) 272-1370. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on (571) 272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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